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APPLICATION NUMBER	FLING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/239,873	01/29/99	LUHMAN	C LL11.12-0040
EXAMINER			
000164 KINNEY & LANGE, P.A. THE KINNEY & LANGE BUILDING 312 SOUTH THIRD STREET MINNEAPOLIS MN 55415-1002		HM12/0716 LEVY, N.	ART UNIT PAPER NUMBER
		1616	13
DATE MAILED: 07/16/01			

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 4/10/01

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-43 is/are pending in the application.  
Of the above, claim(s) 5-27 is/are withdrawn from consideration.  
 Claim(s)  is/are allowed.  
 Claim(s) 1-4, 8-11, 13/4, 28, 32 + 38-43 is/are rejected.  
 Claim(s)  is/are objected to.  
 Claim(s)  is/are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.  
 The drawing(s) filed on  is/are objected to by the Examiner.  
 The proposed drawing correction, filed on  is/are approved  disapproved.  
 The specification is objected to by the Examiner.  
 The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  
 All  Some\*  None of the CERTIFIED copies of the priority documents have been:  
 received.  
 received in Application No. (Series Code/Serial Number)   
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received:

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of Reference Cited, PTO-892  
 Information Disclosure Statement(s), PTO-1449, Paper No(s).  
 Interview Summary, PTO-413  
 Notice of Draftsperson's Patent Drawing Review, PTO-948  
 Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

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Receipt is acknowledged of Amendment of 10/16/00.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 5-7, 12; 15-27 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected inventions and species, the requirement having been traversed in Paper No. 7.

Claims 1-4, 8-11, 13, 14, 28-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Merensalmi 4127676.

The rejection of record is maintained.

New claims are taken from rejected claims 1 and 10.

Claims 1-4, 8-11, 13, 14 and 28-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merensalmi in view of Baalstud et al.

New claims are taken from rejected claims 1 and 10.

Claims 1-4, 8-11, 13, 14 and 28-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 are of copending Application No. 09/338314. Although the conflicting claims are not identical, they are not patentably distinct from each other because the rejection of record is maintained.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Applicant's arguments filed 10/6/00 have been fully considered but they are not persuasive. Applicant argues the restriction and election requirements, but fails to state that (1) the restricted groups are obvious variants of each other and (2) the species are also obvious variants or equivalents of each other, such a declaration by applicant would negate restriction and species requirement. Absent this declaration, the species are seen to be patentably distinct - feeding a cow a tablet is not the same as feeding ad lib, which is not the same as inserting a device in the throat to administer a medicament or feed, which is not the same as parenteral administration or of surgical manipulation, followed by insertion through the surgical area. Neither are the restricted groups seen as patentably the same; the production of a feed is not the same as the feed itself, or the process of administering it to the animal. The processes are both independent of each other and distinct, one from the other.

As to the art rejections, applicant argues Merensalmi shows a fat decrease in %; no increase in milk components, and no projection; further, no in vivo testing is shown. Applicant argues in essence, Baalsrud is cited for background information. As to the double patenting rejection, applicant awaits allowance.

Examiner finds that Merensalmi does what applicant claims - feeds sugar to cows - thus, inherently, the same effects result - Merensalmi does specify an increase milk yield - the % increase maybe low, or negative, yet total amount be higher than without feeding. As to Baalsrud, in essence, it was cited as an indication of rumen - protected feed administration.

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However, merensalmi does state that the sugar alcohols are sufficiently intact (col. 2, lines 49-57). As to the double patenting, it is maintained, as no allowance is yet evident.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 8-11, 13, 14 and 28-37 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims are beyond the scope of the specification, which clearly states (p. 3) that feeding of sugar ~~results in no increase in total solids or alcohols other~~ component content protection is critical claims 1 and 10 are ~~in~~operative.

Claims 1-4, 8-11, 13, 14 and 28-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are ambiguous, in accord with applicants arguments. Arguments and p.3 of the specification lead one to conclude normal feeding, without sufficient protection to prevent

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catabolism of sugar alcohols in the rumen can not result in the claimed component increases.

Claims 1 and 10 do not have restrictions permitting of recognition of a need to prevent alteration of the sugar alcohols. The added features of claims 2, 3, and 4 seem to be repetitive of each other, and imply claim 1 is not requiring protection. The claims should be amended to afford separation of the nature of the claimed material - If what is intended, and this is not clear, is quantitative differences, these differences are not supported, nor are they distinctive - "protecting" and "substantial" and "alteration" all being relative terms, thus requiring quantification and/or explanation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703) 308-2412. The examiner can normally be reached on Tuesday-Friday from 7:00 a.m. to 5:30 a.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-5628. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

N. Levy:jmr

January 05, 2001



NEIL S. LEVY  
PRIMARY EXAMINER